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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,159	06/14/1999	SEAN A. MCCARTHY	10147-6	3785

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EXAMINER

JIANG, DONG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 05/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/333,159

Applicant(s)

MCCARTHY ET AL.

Examiner

Dong Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 12, and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,12,24-28,30-34 and 36-40 is/are rejected.
- 7) ☒ Claim(s) 2, 29, and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED OFFICE ACTION**

Applicant's amendment in paper No. 8, filed on 13 February 2002 is acknowledged and entered. Following the amendment, claims 1, 12, 30, 32, and 37 are amended, and the new claims 39 and 40 are added.

Currently claims 1-7, 12, and 24-40 are pending, and under consideration.

The statement filed on 13 February 2002 regarding an information disclosure statement filed on 09 November 2000 (paper No. 4) has been received. However, the new copy of the form PTO-1449 filed with paper No. 4, and copies of the references as indicated have not been received by the Examiner. The Examiner's attempt to reach the applicant by phone was not successful. Accordingly, the references have not been considered.

#### **Withdrawal of Objections and Rejections:**

The rejection of claims 1-7, 12, and 24-38 under 35 U.S.C. 101, for lack of utility is withdrawn in view of applicant's argument.

The rejection of claims 1-7, 12, and 24-38 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in view of applicant's amendments.

#### **Formal Matters:**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the elected claims are directed.

Applicant is advised that should claim 38 be found allowable, claim 40 will be objected to under 37 CFR 1.75 as being a duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Objections and Rejections under 35 U.S.C. 112:**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, and the dependent claims 3-7, 12, 24-28, 30-34, 36-38 remain rejected, and newly submitted claims 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, because enablement would not be commensurate in scope with these claims, for the reasons of record in the last Office Action, paper No. 7, mailed on 13 September 2001, at page 6.

Applicants arguments, filed on 13 February 2002 (paper No. 8) have been fully considered, but is not deemed persuasive for reasons below.

At pages 7-8 of the response, the applicants argue that TANGO294 is a lipase, that applicants are not required to differentiate the sequence of every fragment of TANGO294 exhibiting or not exhibiting lipase activity, as generating fragments with the activity is routine in the art, and that the issue of probes and primers is irrelevant. These arguments are not persuasive for the following reasons. While the Examiner notes that TANGO294 is a lipase, and agrees that generating functional variants or fragments is routine in the art, the issue is that the claims, with the exception of claims 33, 38, and 40, do not have the functional limitations for the claimed variants (% variants or hybridization variants) and fragments, therefore, read on any or all variants and fragments, including ones having the lipase activity. The specification does not teach how to use those variants and fragments without the functional activity. Additionally, the art generally does not acknowledge that a small portion of a large enzyme molecule, for example, 20 amino acid residues in size, would possess proper enzymatic activity. In the instant case, the entire TANGO294 polypeptide has 423 amino acid residues, a fragment of 20 amino acids (as in claim 1, part d, and claim 30, for example) is less likely to possess the lipase activity. Furthermore, with regards to the functional limitation in claims 33, 38, and 40, even though it is recited that "wherein the polypeptide (the entire molecule encoded by SEQ ID NO:45 or 46) exhibits lipase activity", the claims are directed to small

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fragments of the polypeptide. Therefore, such limitation does not confer a small fragment of 20 amino acids the functional activity.

**Conclusion:**

Claims 2, 29, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Advisory Information:**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
**LORRAINE SPECTOR  
PRIMARY EXAMINER**